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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,427	11/24/2000	Christophe Lacroix	033808.137	1586

7590 10/15/2002

Frederick F. Calvetti
SMITH, GAMBRELL & RUSSELL, LLP
Suite 800
1850 M Street, N.W.
Washington, DC 20036

EXAMINER

SHORT, PATRICIA A

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/15/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-13

Office Action Summary

Application No. 09/718 427	Applicant(s) Lacroix et al	
Examiner Shurt	Group Art Unit 1712	

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on August 8, 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.
- Of the above claim(s) 4, 6, 10, 11 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 5, 7-9, 12, 13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1712

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 12 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP '008. The reference teaches impact modified compositions comprising thermoplastic polyester, core shell impact modifier and an ethylene-unsaturated epoxide copolymer. See examples. The instant claims do not limit the ratio of (B)/(A) in compositions in which the impact modifier is present in amounts of greater than 40 % with respect to the combination of the polyester and impact modifier. The impact modifier KM653 is a polybutadiene/styrene/methyl methacrylate core shell polymer encompassed by the claims or it would have been obvious to use a core shell impact modifier encompassed by the claims. See page 3, lines 35-41. As polycarbonate can function as an impact modifier in a polyester, it is not clear that claim 12 would exclude the polycarbonate of the reference.

Claims 1-3, 5, 7-9, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '008. The reference is discussed above. Additionally, ranges for the components in the composition are taught at page 2, lines 13-24 and ethylene-unsaturated epoxide copolymers are

Art Unit: 1712

taught at page 3, line 42 through page 4, line 9. It would have been obvious to vary the amounts of the components within the ranges taught by the reference in order to obtain an impact modified composition.

Claims 1-3, 5, 8, 9, 12 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dunkle. The reference teaches impact modified compositions comprising thermoplastic polyester, core shell impact modifier and an ethylene-unsaturated carboxylic acid anhydride copolymer. See examples and claim 1. With the exception of claim 9, the claims do not limit the ratio of (B)/(A) in compositions in which the impact modifier is present in amounts of greater than 40 % with respect to the combination of the polyester and impact modifier. The impact modifier KM-330 is a polybutylacrylate/methylacrylate core shell polymer encompassed by the claims or it would have been obvious to use a core shell impact modifier encompassed by the claims. Use of an ethylene-unsaturated carboxylic acid anhydride copolymer is anticipated or would have been obvious over the teachings of the reference. See col. 6, lines 15-18.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1712

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 7-9, 12 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6 and 8 of copending Application No. 09/718,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application overlap with the claims of S.N. 09/718,426. Applicant's reference to the amendment of claim 1 and new claim 11 in S.N. 09/781426 is noted; however, an amendment has not been received in S.N. 09/718,426 nor was a copy enclosed with the response filed in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 1712

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

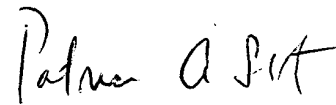
P. Short

October 9, 2002

Phone (703) 308-2395

Fax (703) 872-9311

PATRICIA A. SHORT
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Patricia A. Short".